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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,672	08/05/2003	Masaaki Miyamoto	240086US0CONT	5317
22850	7590	10/24/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BOYKIN, TERRESSA M	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/633,672		MIYAMOTO ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Terressa M. Boykin		1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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**Priority**

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The previous indicated allowability of any of claims 1, 3-49 is withdrawn in view of the STN Structure search which provided newly discovered reference to JP 2003-026913 as well as art previously cited by the applicants. Rejections based on the newly cited reference(s) follow.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3-49 are rejected under 35 U.S.C. 102(b or e) as being anticipated by EP 0736561 see page 1 lines 16-34. pages 7 –8, table 2 and examples 15-17 or JP 2003-026913 see abstract and machine translated claims.**

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The reference discloses an optical disc substrate comprises an aromatic polycarbonate composition containing polycarbonate having main repeating unit(s) of specific structure. The polycarbonate comprises 10-25C aliphatic monocarboxylic acid and 2-10C aliphatic polyhydric alcohol.

Specifically, an optical disc substrate comprises an aromatic polycarbonate composition containing polycarbonate having main repeating unit(s) of formula 1, 2 and/or 3. The polycarbonate has a viscosity average molecular weight of 12000-17000. The polycarbonate composition contains 10-25C aliphatic monocarboxylic acid and 2-10C aliphatic polyhydric alcohol. The disc substrate satisfies the condition,  $0.45 \times H_2 \leq H_1 \leq 1.15 \times H_2$ , where  $H_2$  represents the enthalpy relaxation amount of the aromatic polycarbonate composition (J/g), and is preferably  $H_2=1.5-3.0$ , and  $H_1$  represents enthalpy relaxation amount of the disc substrate (J/g), and is preferably  $H_1=0.9-2.9$ .

The composition is used in optical recording medium for recording, reproducing and erasing information using laser lights.

The optical disc substrate has excellent transferability hence the disc substrate can be exactly molded into desired shape. Deformation of disc substrate is suppressed.

Now turning to **EP 0736561**, the reference discloses a dihydroxy compound. Mixture obtained by adding the ortho,para-bisphenol compound (I)  $R_a, R_b = \text{halo, hydrocarbon; } p = 0-3; q = 0-4; X = O, S, SO, SO_2; (\text{cyclo})\text{aliphatic, aromatic } 6\text{C or higher hydrocarbon group; group of formula } -C(R_c)(R_d)- \text{ (a) or } -C(=R_e)-$

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(b), where  $R_c$ ,  $R_d$  = H, hydrocarbon; and  $R_e$  = hydrocarbon, to a dihydroxy compound having 99-95 wt.% purity or above using UV absorption HPLC. (I) is present at  $5 \times 10^{-5}$  to  $3 \times 10^{-2}$  moles w.r.t. 1 mole of the dihydroxy compound also claimed are: (i) the polymer having units derived from the dihydroxy compound and at least one of its terminal groups is of formula (II); (ii) an optical disk molded from the polymer (i); and (iii) a method for making the polymer (i) comprising melt polycondensing the dihydroxy compound and terminating the polymer with a terminal group of formula (II).

The dihydroxy compound derived polymers are useful in machinery components, electronic components, automobile components, and particular optical disks.

The dihydroxy compound/ ortho, para-bisphenol mixture has outstanding thermal stability and retention of color and transparency during molding.

Thus, each of the references above disclose a branched aromatic polycarbonate prepared from the same components as claimed by applicants and possessing the same structural formulas as claimed as well as the physical and chemical characteristics as well as the ranges as claimed. In view of the above, there appears to be no significant difference between the reference and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

**Correspondence**

**Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is ( 571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free).

tmb

  
**Examiner Terressa Boykin**

**Primary Examiner**

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